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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,751	08/20/2003	William S. Lerner	LERNER	9149

7590 09/20/2004

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NEW YORK, NY 10017

EXAMINER

PAIK, SANG YEOP

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,751

Applicant(s)

LERNER, WILLIAM S.

Examiner

Sang Y Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/12/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Statutory Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1 and 2 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,639,190. This is a double patenting rejection.

The patented claims include all the elements recited in the pending claims 1 and 2 including the liquid crystal composition, the container, the liquid crystal composition shaped to convey "HOT" symbol that turns red, and the attachment.

In claims 1 and 2 of the pending application, the recitation of "the color change revealing an outline of the letters 'HOT'" is an alternatively worded recitation that carries the same scope as the patented recitation of "to convey an outline of the letters 'HOT'" that turns its color to red. Although the claims do not recite its elements in exact terms, the recitation having the same scope that is differently worded is subject to the statutory double patenting.

3. Claims 3-6 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 4 of prior U.S. Patent No. 6,104,007. This is a double patenting rejection.

The patented claims include all the elements recited in the pending claims 3 to 6 including the electric stove with an insulated serpentine electric coil, and the central disk having

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the liquid crystal composition with the letters "HOT" that turns to color red; or the gas stove with an central metal element with a series of gas inlet holes and a disk to form "HOT" in the disk.

The recitation in the pending claims 3 and 5 which recites "the color changes revealing a shape of the letters 'HOT'" is an alternatively worded recitation that carries the same scope as the patented claims and thus subject to the statutory double patenting.

Non-Statutory Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 7-9 and 16-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,639,190 in view of Hodson et al (US 3,585,381) or Balderson (US 4,983,810).

Claims 1 and 2 of the Patent '190 include all the recited elements except the recited term "thermochromic" composition.

Hodson et al teaches that thermal responsive color changing liquid crystal composition is known in the art to exhibit chromatic response to the thermal changes. Balderson also shows a thermochromic composition that changes its color in response to thermal changes.

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In view of Hodson et al or Balderson, it would have been obvious to one of ordinary skill in the art to use thermochromic composition, as the liquid crystal composition, that is well known in art to display colorization changes in response to thermal variances; and for the aesthetic purposes, it would have been obvious to one of ordinary skill in the art to provide the background of a hot surface not readily visible against the composition when the composition does not exceed the predetermined temperature.

Furthermore, since the “HOT” symbol in the patented claims is designed to warn the users, it would have been obvious to one of ordinary skill in the art to use any other symbol other than “HOT” to indicate the dangerous conditions of a heating device since

6. Claims 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,639,190.

Claims 1 and 2 of the Patent ‘190 include all the recited elements except the conflicting terms or recitations of “warning symbol”. While the terms are not identical, they are not patentably distinct from each other because the “HOT” symbol in the patented claims is designed to warn the users, and it would have been obvious to one of ordinary skill in the art to use any other symbol other than “HOT” to indicate the dangerous conditions of a heating device.

7. Claims 12-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,104,007.

Claims 1 and 2 of the Patent ‘007 include all the recited elements except the conflicting terms or recitations of “warning symbol”. While the terms are not identical, they are not patentably distinct from each other because the “HOT” symbol in the patented claims is designed

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to warn the users, and it would have been obvious to one of ordinary skill in the art to use any other symbol other than "HOT" to indicate the dangerous conditions of a heating device.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sang Y Paik whose telephone number is 703-308-1147. The examiner can normally be reached on M-F (9:00-4:00) First Friday Off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Paik

Sang Y Paik
Primary Examiner
Art Unit 3742

syp